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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,152	10/06/2000	Sean Hu	PSTM0034/MRK	9961
29524	7590	08/01/2005	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 08/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,152

Applicant(s)

HU ET AL.

Examiner

Jamisia A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-24, 26, 27 and 30-55 is/are pending in the application.
- 4a) Of the above claim(s) 21-24, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-20, 26, 27, 30-35 and 38-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050512</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claims 42 and 48: the phrase "displayed on a predetermined number of lines" is indefinite. It is unclear to the examiner what this phrase is trying to actually claim. Does this have to do with the size of the display? What does it mean by lines?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-20, 26, 27, 30-35, 38-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (6,233,568) in view of Nicholls et al. (5,631,827) and Martin et al. (6,078,936).
6. With respect to Claims 5-8, 10-12, 14-18, 26-33, 35, and 38-55: Kara discloses the use of a Shipping Management Computer System (see abstract) that is programmed to recognize a set

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of graphic resolution characteristics of a printer device (See Figure 6 and column 4, lines 49-54). Kara discloses the computer system used to create and generate a shipping label image bearing a dimensionally accurate symbology for display (See Figure 9). The examiner considers this window to be a browser window, due to the fact that the user can browse the program, and therefore the program used, the examiner considers to be browser software. Kara also discloses the step of generating a shipping label according to a set of rules for a particular service of a particular carrier and according to the selection of the user (see Figures 6-9 and column 5, lines 43-47, column 6, lines 22-32). Kara discloses the users having a remote communication link such as the internet (See Claim 45), the examiner considers this to be global communication link, since the internet can be accessed at any location across the globe. It is also the examiner's position that the system is for multiple users, therefore would have multiple printer devices.

7. Kara discloses that the program can run on a host system (Column 22, lines 11-33), but does not disclose that computer system that is remote from the user client computer device, generates the shipping label and sends the image to the client computer device. Nicholls discloses a shipping system with servers, that are accessed by a client device (column 4, lines 30-63), where the servers store data and runs administration programs such as generating shipping labels (column 8 line 65 to column 9, line 14). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Kara, so that there is a central server, which stores information such as rates and creates documents such as shipping labels, in order to allow updates and changes to the data without affecting the remaining programs/systems. (See Nicholls, column 4)

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8. Kara and Nicholls disclose the use of displaying the shipping label before printing, but fails to specifically disclose the display being electronically formatted for a particular printing device, where the system recognized the graphic resolution characteristics of the shipping device for printing. Martin discloses the use of a display with a resolution to display images being dimensionally accurate, and to display the image as it would appear on an output device such as a printer (see abstract, Column 9, lines 43-55, column 10, lines 16-23, and Column 14, lines 11-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Kara and Nicholls, to have the display image of the shipping label, appear on a display the same as it would appear on a printing device, as disclosed by Martin, in order to provide a visualization of how a specific output device such as a printer, would present an image, in order to view the printed matter substantially the same as it would be printed out on an output device (See Martin, Columns 2-4).

9. With respect to Claims 8, 18 and 33: See Kara, Figures 8 and 9 with corresponding detailed descriptions, and Column 6, lines 22-39.

10. With respect to Claims 9, 10, 19, 20, 34 and 35: See Kara, Reference numeral 710 and column 19 line 66 to column 20, line 61.

11. With respect to Claims 13: Kara and Martin, as disclosed above for Claim 5, discloses the use of a printing device which can be a printer that is currently used by a computer system, and discloses the display to be representative of the particular printing device, but fails to specifically disclose using a laser printer.

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12. At the time the invention was made, it would be been an obvious matter of design choice to a person of ordinary skill in the art to use a laser printer for generating the shipping labels because Applicant has not disclosed that using a laser printer provides an advantage, is used for a particular purpose or solves any stated problem. One of ordinary skill in the art furthermore, would have expected Applicant's invention to perform equally well with any printer whether it be a laser printer or an ink jet printer because they both provide the overall result of generating a shipping label.

Response to Arguments

13. Applicant's arguments with respect to claims 5-35 have been considered but are moot in view of the new ground(s) of rejection.

14. In response to Applicant's argument that Martin solves a different problem than the application for displaying accurate shipping labels according to the printing device, the fact that Applicant solves a different problem for displaying a shipping label does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. *In re Linter*, 173 USPQ 560. Martin discloses the image input can be automatically retrieved (Column 9) and discloses that the image can be sent or displayed over a network, which is remote to the user, and discloses the image is modified for different output devices, such as a printer. Therefore it is the examiner's position that Martin does provide the use of displaying a dimensionally accurate shipping label, based on the characteristics of the output device that are obtained. Therefore the rejection stands as stated above.

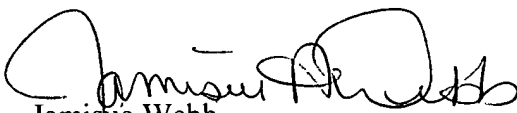
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811.

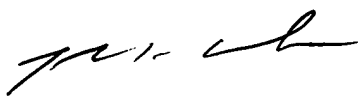
The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamisue Webb



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